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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/642,526	08/18/2000	Asit Dan	YOR9-2000-0164-US1	7786

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William E Lewis
Ryan & Mason LLP
90 Forest Avenue
Locust Valley, NY 11560

EXAMINER	
KAPADIA, MILAN S	
ART UNIT	PAPER NUMBER
3626	

DATE MAILED: 08/19/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/642,526	DAN ET AL.	
	Examiner	Art Unit	
	Milan S Kapadia	3626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *04 June 2003* .

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-26 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-26* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Notice to Applicant

1. This communication is in response to the amendment filed 4 June 2003. Claims 1-26 are pending.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-6, 10-18, and 22-26 are rejected under 35 U.S.C. 102(b) as being anticipated by O'Brien et al. (WO 97/29443 (as cited in Applicant's IDS)).

(A) As per claim 1, O'Brien discloses an apparatus for use in a computer hosting services environment, the apparatus comprising: at least one processor (O'Brien; page 1, lines 6-13) operative to: (1) construct an electronic service level agreement between a service provider and a client based on client input for an application associated with the client to be hosted by the service provider (O'Brien; page 8, lines 18-29 and page 16, lines 11-21); and (ii) check the consistency of the electronic service level agreement with respect to one or more existing electronic service level agreements previously

committed to by the service provider (O'Brien; page 3, lines 18-22 page 6, lines 23-28 and 32-page 7, line 6).

(B) As per claim 2, O'Brien teaches wherein the at least one processor is further operative to modify the electronic service level agreement when at least one inconsistency is found (O'Brien; page 16, line 26-page 17, line 2).

(C) As per claim 3, O'Brien teaches wherein the at least one processor is further operative to provision one or more resources of an infrastructure on which the application is to be hosted in accordance with the constructed electronic service level agreement (O'Brien; page 17, lines 11-18).

(D) As per claim 4, O'Brien teaches wherein the at least one processor is further operative to execute the constructed electronic service level agreement (O'Brien; page 17, lines 11-28).

(E) As per claim 5, O'Brien teaches wherein the at least one processor is further operative to report one or more events associated with the execution of the constructed electronic service level agreement (O'Brien; page 17, lines 18-28 and page 30, lines 18-24).

(F) As per claim 6, O'Brien teaches wherein the one or more events comprise at

least one of a violation of a portion of the electronic service level agreement and a near-violation of a portion of the electronic service level agreement (O'Brien; page 7, line 30-page 8, line 4).

(G) As per claim 10, O'Brien teaches wherein the at least one processor is further operative to determine whether the electronic service level agreement will be satisfied for a given workload based on historical data (O'Brien; page 6, line 32-page 7, line 6).

(H) As per claim 11, O'Brien teaches wherein the at least one processor is further operative to determine for how long the electronic service level agreement will be satisfied based on a workload forecasting and performance prediction technique (O'Brien; page 6, line 16-page 7, line 6 and page 16, line 11-page 17, line 18).

(I) As per claim 12, O'Brien teaches wherein the constructing operation comprises determining pricing for inclusion in the electronic service level agreement associated with the hosting of the application by the service provider (O'Brien; page 6, line 16-page 7, line 6 and page 16, line 11-page 17, line 18).

(J) Method claims 13-18 and 22-24 repeat the subject matter of apparatus claims 1-6 and 10-12, respectively, as a series of steps rather than a set of apparatus elements. As the underlying structure of claims 1-6 and 10-12 have been shown to be fully disclosed by the teachings of O'Brien in the above rejections of claims 1-6 and 10-12, it

is readily apparent that the apparatus disclosed by O'Brien includes the steps to perform these functions. As such, these limitations are rejected for the same reasons given above for apparatus claims 1-6 and 10-12, and incorporated herein.

(K) Claim 25 repeats the features of claim 1 and is therefore rejected for the same reasons given above in the rejection of claim 1 and incorporated herein.

(L) Claim 26 repeats the features of claims 1-4 and is therefore rejected for the same reasons given above in the rejections of claims 1-4 and incorporated herein.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 7-9 and 19-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over O'Brien et al. (WO 97/29443) as applied to claims 5 and 17 above and further in view of Main et al. (5,893,905).

(A) As per claims 7 and 8, O'Brien fails to expressly teach wherein the at least one

processor is further operative to provide a warning or an alarm that a portion of the electronic service level agreement is one of violated and near-violated. However, this feature is old and well known in the art, as evidenced by Main's teachings with regards to wherein the at least one processor is further operative to provide a warning or an alarm that a portion of the electronic service level agreement is one of violated and near-violated (Main; abstract). It is respectfully submitted, that it would have been obvious, to one having ordinary skill in the art at the time the invention was made, to expand the system taught by O'Brien with Main's teaching with regards to this limitation, with the motivation of alerting service requestor of the potential impact of SLA violation (Main; abstract).

(B) As per claim 9, O'Brien fails to expressly teach wherein the at least one processor is further operative to provide an explanation as to why a portion of the electronic service level agreement is one of violated and near-violated. However, this feature is old and well known in the art, as evidenced by Main's teachings with regards to wherein the at least one processor is further operative to provide an explanation as to why a portion of the electronic service level agreement is one of violated and near-violated (Main; abstract). It is respectfully submitted, that it would have been obvious, to one having ordinary skill in the art at the time the invention was made, to expand the system taught by O'Brien with Main's teaching with regards to this limitation, with the motivation of alerting service requestor of the potential impact of SLA violation (Main; abstract).

(C) Method claims 19-21 repeat the subject matter of apparatus claims 7-9, respectively, as a series of steps rather than a set of apparatus elements. As the underlying structure of claims 7-9 have been shown to be fully disclosed by the teachings of O'Brien and Main in the above rejections of claims 7-9, it is readily apparent that the apparatus disclosed by O'Brien and Main includes the steps to perform these functions. As such, these limitations are rejected for the same reasons given above for apparatus claims 7-9, and incorporated herein.

Response to Arguments

6. Applicant's arguments filed 6/4/03 have been fully considered but they are not persuasive. Applicant's arguments will be addressed herein below in the order in which they appear in the response filed 6/4/03.

(A) At pages 1-3 of the 6/4/03 response, Applicant argues that "... the present invention discloses a system in which the consistency of a proposed SLA is checked with respect to existing SLAs, while the service system of O'Brien compares a proposed SLA to stored parameters" in reference to claims 1, 13, 25, and 26. In response, the Examiner respectfully notes that the Applicant has not considered the full teachings of O'Brien. O'Brien, as also shown on page 2 Applicant's response filed 6/4/03, teaches that checking the consistency of a SLA with stored parameters

(O'Brien; col. 6, lines 23-28). O'Brien further teaches that the "stored parameters" are based on existing SLAs (O'Brien; pag3 3, lines 18-32). As such, it is respectfully submitted, O'Brien teaches the recited limitations.

(B) At pages 2-3 of the 6/4/03 response, Applicant argues that "... O'Brien does not disclose a system able to determine how long the electronic service level agreement will be satisfied based on a workload forecasting and performance prediction techniques" in reference to claim 11. In response, the Examiner is concerned that, aside from merely alleging that certain claimed features are not anticipated by O'Brien essentially in the form of blanket statements, Applicant does not point to any specific distinction(s) between the features disclosed in the references and the features that are presently claimed. In particular, 37 CFR 1.111(b) states, "A general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the reference does not comply with the requirements of this section." Applicant has failed to specifically point out how the language of the claims patentably distinguishes them from the applied references. Also, arguments or conclusions of Attorney cannot take the place of evidence. *In re Cole*, 51 CCPA 919, 326 F.2d 769, 140 USPQ 230 (1964); *In re Schulze*, 52 CCPA 1422, 346 F.2d 600, 145 USPQ 716 (1965); *Mertizner v. Mindick*, 549 F.2d 775, 193 USPQ 17 (CCPA 1977). The Examiner maintains the recited features are taught by O'Brien as shown above in the rejection of claim 11 and incorporated herein.

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Milan S Kapadia whose telephone number is 703-305-3887. The examiner can normally be reached on Monday through Thursday, 8:30 A.M. to 6:00 P.M. In addition the examiner can be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on 703-305-9588. The fax phone

numbers for the organization where this application or proceeding is assigned are 703-305-7687 for regular communications and 703-305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

mk

August 14, 2003

JOSEPH THOMAS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600